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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,760	07/31/2001	Paul Douglas Scotti	514274-2001	6462

7590 10/01/2002  
Frommer Lawrence & Haug  
745 Fifth Avenue  
New York, NY 10151

EXAMINER

PAK, YONG D

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 10/01/2002

11

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/868,760	<b>Applicant(s)</b> SCOTTI ET AL.	
	<b>Examiner</b> Yong Pak	<b>Art Unit</b> 1652	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☐ Responsive to communication(s) filed on \_\_\_\_.

2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) 1-24 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_ is/are allowed.

6) ☐ Claim(s) \_\_\_\_ is/are rejected.

7) ☐ Claim(s) \_\_\_\_ is/are objected to.

8) ☒ Claim(s) 1-24 are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All   b) ☐ Some \*   c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) <input type="checkbox"/> Notice of References Cited (PTO-892) 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) 6) <input type="checkbox"/> Other:
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**DETAILED ACTION**

This application is a 371 of PCT/NZ99/00227.

Claims 1-24 are pending.

***Election/Restrictions***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-8 and 14-20, drawn to a serine protease inhibitor.

Group II, claim(s) 9-13, drawn to DNA encoding the protein of Group I, vector comprising said DNA and a host cell comprising said DNA.

Group III, claim(s) 21-24 drawn to a method of producing the serine protease inhibitor.

The inventions listed as Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The technical feature linking I-III appears to be that they all relate to serine protease inhibitors.

Groups I- III do not share a technical feature because the DNA molecule of Group II (claim 10) can encode a polypeptide not having the structure of the protein of Group I. For a DNA and protein group to share a special technical feature, claims

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drawn to the DNA must be DNA sequences that encode the structure of the protein in the claims drawn to the protein (see PCT administrative instructions Example 17).

Therefore, the technical feature linking Group I and Groups I-V is lacking.

In addition to election of one of Group I-III, applicants are required to further elect ONE patentably distinct serine protease inhibitor sequence or ONE DNA sequence encoding the serine protease inhibitor. The disclosure contains many serine protease inhibitor from different source with different structure and different function.

Under 37 CFR 1.475 (d), a national stage may not relate to multiple products or multiple processes in one application.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Pak whose telephone number is 703-308-9363. The examiner can normally be reached on 8:00 A.M. to 4:30 P.M weekdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on 703-308-3804. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Yong Pak  
Patent Examiner

September 26, 2002



PONNATHAPU ACHUTAMURTHY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600



COPY OF PAPERS  
ORIGINALLY FILED

PATENT  
514274-2001

1651

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Scotti et al.  
Serial No. : 09/868,760  
Filed : July 31, 2001  
For : SERINE PROTEASE INHIBITORS  
Group Art Unit : 1651

RECEIVED

AUG 06 2002

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745 Fifth Avenue  
New York, New York 10151

I hereby certify that this correspondence is being deposited with  
the United States Postal Service as first class mail in an envelope  
addressed to: Assistant Commissioner for Patents, Washington,  
DC 20231, on July 23, 2002  
William F. Lawrence Reg. No. 28,029

Name of Applicant, Assignee or Registered Representative

Signature

Date of Signature

INQUIRY LETTER

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

Inquiry is respectfully made as to the status of this patent application.

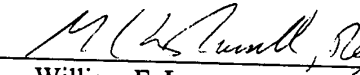
Applicants filed a national phase patent application and Information Disclosure  
Statement on June 21, 2001. An Amendment to Accompany Sequence Listing Statement to  
Support Filing and Submission, diskette and paper copy of Sequence Listing was filed on July

11, 2001. A Communication and executed Declaration was filed on July 31, 2001. No action has been received from the Patent and Trademark Office.

Early and favorable examination on the merits is earnestly solicited.

Respectfully submitted,

FROMMER LAWRENCE HAUG LLP  
Attorneys for Applicants

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